

## REMARKS

Claims 1-23 are pending and at issue in the instant case, and examined in the Final Office Action mailed on September 10, 2007, claims 28-31 having been withdrawn from consideration.

Claims 1-10 and 15-23 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with written description.

Claims 1-23 were rejected under 35 U.S.C. §112, first paragraph, as allegedly not being enabled.

## REJECTIONS OF THE CLAIMS UNDER 35 U.S.C. §112

(a) The Examiner rejected claims 1-10 and 15-23 under 35 U.S.C. §112, first paragraph as allegedly failing to comply with written description.

The applicants traverse the rejection. The written description requirement is satisfied when the description clearly allows persons skilled in the art to recognize what has been invented (*see, In Re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ 2d 1614, 1618 (Fed Cir. 1989); MPEP 2163 et. Seq.). Claim 1 recites a "...promoter operatively linked to the coding sequence for an enzyme having selected enzymatic activity..." The applicants had previously argued that structural information, for example sequence information of an enzyme having selected enzymatic activity, would be readily available to one skilled in the art once a desired enzyme has been selected. Structural information would not be required for one skilled in the art to recognize what has been invented, and the claim satisfies the written description requirement in that sense.

The Examiner rejected the applicants arguments stating that the disclosure is limited to  $\beta$ -lactamase and the two probes of Figures 6 and 8, and these species were not representative of the entire genus of probes and enzymes. The applicants are attaching a declaration by Ahmed Chenna, Ph.D. Dr. Chenna's primary research relates to assay development, and design and synthesis of cleavable tags for bio-conjugation to proteins and antibodies and for gene expression products. As stated by Dr. Chenna, multiplexed assays outlined and claimed in the '079 application satisfy the requirements for written description, and the specification provides structural information on the separation modifier for the probes to be used in the assays. Accordingly, reconsideration and withdrawal of the rejection according to that rationale are respectfully requested.

(b) The Examiner rejected claims 1-23 under 35 U.S.C. §112, first paragraph as allegedly not being enabled by the specification.

The applicants traverse the rejection. The test of enablement is whether the disclosure and the art at the filing date of the application are sufficient to allow one skilled in the art to practice the claimed invention without undue experimentation. In the Final Office Action, the Examiner stated: "Therefore, Applicant's argument that one of ordinary skill in the art would be able to select an enzyme to practice the assay in spite of the large genus of enzymes due to the information provided in the instant disclosure as well as the disclosure of U.S. Patent No. 6,627,400 is not found persuasive." The Examiner maintained that undue and burdensome amount of experimentation would be required.

In the attached declaration, Dr. Ahmed Chenna states that at the time of the invention, one of skill in the art could select an enzyme and either obtain its sequence information or obtain

it from commercial sources, and based on the specification of the '079 application and what was known in the art at the time the invention was made, one of skill in the art could readily determine which separation modifiers to use, and determined the level of transcriptional response of each cell to the potential regulatory stimulus to which the cells were exposed from the electrophoretic mobility and level of detection group of each separated c-tag reporter. Thus, as Dr. Chenna's declaration makes clear, undue and burdensome experimentation would not be required to practice the invention. Therefore, the Examiner is respectfully requested to withdraw the rejection.

### **CONCLUSION**

Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested.

Respectfully submitted,  
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